

REMARKS

Claims 94, 96-121, 124, 127-170 remain pending in the above-referenced patent application. Of these, claims 94, 96-103, 106, 107, 112, 115, 116, 121, 124, 127, 129-145, 151, 152, 158 and 163-165 have been considered on the merits. Claims 166-170 were not previously examined on the merits due to an objection as to form. Claims 104, 105, 108-111, 113, 114, 117-120, 128, 146-150, 153-157 and 159-162 have been withdrawn from consideration as being drawn to a non-elected species. Applicants respectfully request further consideration of the claims, in view of the amendments set forth above and the following remarks.

Amendments to the Claims

Claims 136 and 160 have been amended to make a minor grammatical correction, without change in the substantive scope thereof. Claims 166-170 have been amended as to form, without change in the substantive scope thereof. No new matter is added.

Acknowledgements

Applicants acknowledge that various rejections set forth previously by the Office have been withdrawn.

In particular, the Office has withdrawn the previous rejection set forth under 35 U.S.C. §112 (written description) of claims 94-103, 106, 107, 112, 115, 116, 121, 123, 124, 126, 127, 129-145, 151, 152, 158 and 163 as containing subject matter which was not adequately described in the specification. *See* paragraphs 12-13 at page 5 of the Office action.

The Office has also withdrawn the previous rejection of claims 94-103, 106, 107, 111, 115 and 116 under 35 U.S.C. §112, 2nd paragraph, as being indefinite. *See* paragraphs 27-28 at page 10 of the Office action.

Additionally, the Office has withdrawn the rejection claims 94-103, 106, 107, 112, 115, 116, 121, 123, 124, 126, 127, 129-145, 151, 152 and 158 under 35 U.S.C. § 103(a) as being obvious based on Rolleston *et al.* (U.S. Patent No. 5,416,613) and Howard *et al.* (U.S. Patent No. 3,868,221) in view of Baldeschweiler *et al.* (U.S. Patent No. 5,847,105)

and Leasure *et al.* (1994) and Gallop *et al.* (1994). *See* paragraphs 29-31 at pages 10-11 of the Office action.

Objections Under 37 C.F.R. § 1.75(c) (Claim Form)

The Office action has objected to claims 166-170 as being in improper multiple-dependent form. Applicants have amended the claims to obviate this basis for objection. Applicants respectfully request consideration of these claims on the merits.

Rejections Under 35 U.S.C. § 112 (New Matter)

The Office action rejects independent claim 163, together with dependent claims 164 and 165, under 35 U.S.C. § 112, 1st paragraph, as being new subject matter which was not adequately described in the specification. In particular, the Office action states that “(t)his rejection maintains the reasons of record for rejection of claim 163, as set forth in the previous Office action, mailed 4/9/2003.” (*See* paragraphs 7 at page 3 of the Office action; *see also* paragraphs 8 through 11 at pages 4-5 of the Office action).

Applicants respectfully request reconsideration of this rejection, in view of the following remarks.

Substantial amendments to claim 163 were made in the Supplemental Amendment D filed December 4, 2003 in response to the Office action dated April 9, 2003 to obviate this basis for rejection. These amendments were specifically discussed with Examiner M. Baker during an interview on October 29, 2003, as discussed in the aforementioned Amendment D. Examiner Baker indicated that the amendments would obviate this basis for rejection, but she reserved a decision for further consideration once the amendments were made of record.

Applicants recognize that a new Examiner has been assigned to this application. It is not clear from the instant Office action, however, whether the amendments to claim 163 as presented in Amendment D – subsequent to the referenced rejection of April 9, 2003 – have been considered by the Office. In particular, since the instant Office action only makes reference to a rejection that pre-dates the most recent amendments to claim 163, and since the instant Office action expressly refers to Applicants’ arguments filed October 2,

2003 [sic: October 9, 2003 in Amendment C], the Office action does not appear to address claim 163 as presently pending.

Accordingly, Applicants respectfully request reconsideration of claim 163 as now pending in view of the amendments made thereto in Amendment D (dated October 29, 2003).¹

Notwithstanding, the following remarks are responsive to comments set forth in the Office action at page 4, paragraph 10. In this paragraph, the Office questions where the written description support can be found for delivering components to a third, fourth, fifth, sixth, seventh, eighth, ninth and tenth region, for forming a third, fourth, fifth, sixth, seventh, eighth, ninth and tenth polymer, and for ten or more regions / polymers.

Applicants respectfully submit that a person of ordinary skill in the art would have understood that the Applicants were in possession of the invention defined by claim 163. In particular, the specification demonstrates, with abundance, that Applicants were in possession of applying the recited method to form each of ten or more polymers at each of ten or more discrete regions of a substrate. For example, it is stated in the Summary of the Invention that

In one embodiment of the present invention, a first component of a first material is delivered to a first region on a substrate, and a first component of a second material is delivered to a second region on the same substrate. Thereafter, a second component of the first material is delivered to the first region on the substrate, and a second component of the second material is delivered to the second region on the substrate. The process is optionally repeated, with additional components, to form a vast array of components at predefined, i.e., known, locations on the substrate.

See page 4, lines 24-30 of the specification. (emphasis added). *See also* page 13, lines 6-21 of the specification. It is further disclosed that arrays can consist of more than 10

¹ To the extent that Applicants' premise is incorrect, and the rejection as set forth in the instant Office action is intended to be directed to Claim 163 as amended following Amendment D and as presently-pending, then Applicants respectfully request that the Office set forth an updated basis for rejection (if the present basis for rejection is not overcome following consideration of the remarks herein), since the previously-detailed basis for rejection set forth in the April 9, 2003 Office action (and incorporated by reference into the instant Office action) relates to a previously-pending version of claim 163 which, considered as a whole, was directed to different subject matter than the presently-pending claim 163.

different compounds. *See* page 6, lines 4-5 of the specification. Further detailed discussion of numbers of materials which can be synthesized at discrete regions of a substrate is also provided, to wit:

In preferred embodiments, a single substrate has at least 10 different materials and, more preferably, at least 100 different materials synthesized thereon. In even more preferred embodiments, a single substrate has more than 10^3 , 10^4 , 10^5 , 10^6 , or more materials synthesized thereon.

See page 18, lines 3-6 of the specification (emphasis added). Additionally, in Example B, an array of sixteen different polymers are synthesized on a substrate having sixteen reaction regions, by a method that includes delivering components (*e.g.*, monomers) to each of the sixteen regions (*i.e.*, to a first region, a second region, to a third region, to a fourth region, to a fifth region...*etc.*). *See* page 49, line 4 through page 50, line 20 of the specification.

Hence, the specification is abundantly clear that Applicants contemplated, as part of their inventions, methods that involved preparing arrays of ten or more polymers by delivering components to each of the ten or more regions – *i.e.*, to each of at least a first region, second region, third region, fourth region, fifth region, sixth region, seventh region, eighth region, ninth region and tenth region.

In view of the aforementioned discussion, Applicants respectfully submit that a person of ordinary skill would have understood Applicants to have been in possession of the invention as defined in claim 163 and claims depending therefrom.

Rejections Under 35 U.S.C. § 112 (Enablement)

The Office action maintains the rejection of each of the considered claims (claims 94, 96-103, 106, 107, 112, 115, 116, 121, 124, 127, 129-145, 151, 152, 158 and 163-165) under 35 U.S.C. §112 as being non-enabled by the specification. Specifically, it is alleged that the specification would not have enabled a person of ordinary skill in the art to make and/or use the invention commensurate in scope with these claims, without undue experimentation. (*See* paragraph 14 at pages 5-6 of the Office action; *see also* paragraphs 15-25 at pages 6-9 of the Office action).

Applicants traverse this basis for rejection, and respectfully request reconsideration in view of the following remarks. These remarks supplement those remarks already of

record in Amendment C, Supplemental Amendment D and Supplemental Amendment E. These remarks also supplement, as well as rely upon, the evidence of record in the form of the Declaration of Adam L. Safir (filed February 13, 2004 in connection with Amendment E).

The Office action acknowledges that the specification is enabling for preparing arrays of polymers by copolymerization of styrene and acrylonitrile, and screening such arrays for a physical property. The Office action asserts, nonetheless, that the specification:

does not reasonably provide enablement for making an array of any type of 'non-biological organic polymers' and screening the array for any 'property of interest' as broadly called for in the claims.

See paragraph 14 at page 5 of the Office action. (emphasis added).

In this regard, Applicants note that independent claims 94, 121, 124 and 135 were amended in the Supplemental Amendment D filed December 4, 2003 in response to the Office action dated April 9, 2003 to obviate this basis for rejection. These amendments, which were discussed with Examiner M. Baker during the previously-mentioned interview on October 29, 2003, clarify that the present claims are not directed to *any* type of non-biological organic polymer (as asserted in the Office action), but rather, require that the non-biological organic polymers are co-polymers or higher-ordered polymers. Likewise, Applicants note that claims requiring screening steps (*e.g.*, claims 112, 121, 138-143 and 163-165) are not directed to *any* property of interest (as asserted in the Office action), but rather, require screening for particular types of properties – such as a thermal property or a chemical property or a morphological property. Accordingly, the underlying factual basis for the instant rejection appears to be unclear with respect to these claims. Applicants request reconsideration of these claims as *presently pending*, taking into account the following remarks.

Applicants respectfully submit that a person of ordinary skill in the art would have been enabled to make and use the presently-claimed inventions at the time such application was filed, and that the Office has not established a *prima facie* case of non-enablement.

The invention is directed, *inter alia*, to forming arrays comprising different non-biological polymers by delivering monomers (or in some claims, co-monomers) to

different regions of a common substrate, and then simultaneously polymerizing to form different polymers at the different regions. Certain claims require a further screening step for evaluating the resulting polymers. Significantly, a person of ordinary skill in the art would have recognized that Applicants' invention represents new formats, approaches and protocols for investigating (*e.g.*, discovering and/or optimizing) non-biological polymeric materials – generally, and without regard to particular polymerization chemistries. A skilled artisan would have recognized, therefore, that the invention can be effected with existing, known polymerization chemistries.

Significantly, the scope of the presently-pending claims is entirely consistent with the scope of the invention as disclosed in the specification. In such a situation, with respect to enablement concerns,

it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement.

See In re Marzocchi, 169 USPQ 367, 369, 370 (CCPA 1971) and MPEP § 2164.04 (emphasis in original).

In the present case, however, the Office action relies on conclusory statements supported only by an assertion that the polymerization arts are generally unpredictability. In this regard, for example, the Office refers to statements made by Applicants and by Applicants' declarant, Dr. Adam L. Safir. For example, the Office action states that "(b)oth applicant's arguments and the Safir Declaration explicitly state that the art of polymer preparation is unpredictable." (*See* paragraph 21 at page 8 of the Office action).

However, the Office's reliance on such statements is misplaced. The Office appears to have either misunderstood or misconstrued Applicants' statements in this regard to some extent, and/or to have taken such statements out of context. For example, the Declaration of Adam L. Safir did in fact state that

it is the is the inherent unpredictability in the art of polymer structures that makes the invention particularly useful – because it provides a protocol and format that offers significant advantages for investigating polymers and polymerization reactions.

See paragraph 22 of the Declaration of Adam L. Safir (emphasis added). Dr. Safir was referring in this statement to the unpredictability associated with *particular* experiments in which the inventions are used to make *new discoveries* – that is, whether particular *polymer structures* having particular properties of interest will result from particular polymerization reactions under a particular set of reaction conditions. At most, this statement acknowledges that the state of the polymerization arts has not advanced to point where new polymer structures and new polymer properties can be predicted *a priori* for a particular reaction from a set of starting materials and a set of reaction conditions. As such, contrary to the position taken by the Office, this statement by Dr. Safir and similar statements made by Applicants cannot form the foundation for the generalized assertion that the field of polymerization is so unpredictable that Applicants invention would not have been enabled.

In fact, other statements made by Dr. Safir and by Applicant expressly refute such generalized assertion. For example, Dr. Safir states that

many known polymerization techniques and chemistries can be used to practice this invention, as is demonstrated in the Exhibits discussed herein, as the state of the art for polymerization is well developed.

See paragraph 21 of the Declaration of Adam L. Safir, filed February 13, 2004 (emphasis added). Hence, even though there is unpredictability in the art with respect to forming *particular new polymer structures* or obtaining *new polymers* having *particular properties*, there are numerous well-known *polymerization techniques and chemistries* that can be employed in practicing Applicants' invention.

Accordingly, the Office's basis for asserting non-enablement is not supported by the facts of record, and amounts only to conclusory statements.

Moreover, the Office action appears to be misapplying the law. For example, the instant Office action posits with respect to the uncertainty in the art that:

it is the unpredictability of the art that will limit the usefulness of the claimed invention, because the making and screening of any non-biological organic polymer, as encompassed by [sic: the] breadth of the claims, will at some point require methods and screening that are not routine. ...

See paragraph 21 at page 8 of the Office action. The Office action further argues that:

(t)he specification and the Safir declaration refer to established chemistry, but the claimed invention, in making and assaying any polymer, must go beyond firmly established chemistry because the synthetic intermediates can be numerous, structurally complex, in small quantity and not amendable to routine purification and characterization techniques.

See paragraph 22 at pages 8-9 of the Office action.

However, the law requires that the scope of the claims be enabled as of the time the application was filed. Subsequent advances or improvements in the art, even if patentably distinct, do not have to be enabled. See *U.S. Steel Corp. v. Phillips Petroleum Co.*, 9 USPQ2d 1461 (Fed. Cir. 1989), *citing* *In re Hogan*, 194 USPQ 527, 537-538 (CCPA 1977). It is sufficient under the law that Applicants' invention is enabled for polymerization techniques and polymer structures known in the art as of the date of filing of the instant application. The law does not require that Applicants enable new polymer structures and/or new polymer properties and/or new polymerization syntheses. Therefore, the aforescribed assertions by the Office that the claimed invention "will at some point require methods and screening that are not routine" and that the claimed invention "must go beyond firmly established chemistry" have no legal bearing on the analysis of whether or not the presently-pending claims are enabled.

Further, as detailed in previously-submitted amendments, the present invention is clearly enabled by the teaching and guidance provided in the specification, considered in combination with the extensive warehouse of knowledge already existing in the art.

Enablement is a legal determination of whether the patent would enable a person of ordinary skill in the art to make and use the claimed invention. (See *Hybritech Incorporated v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 94 (Fed. Cir. 1986)). Although the scope of protection sought in a claim must bear a reasonable correlation to the scope of enablement provided in the specification (See *In re Fischer*, 166 USPQ 18, 24 (CCPA 1970)), the specification must be considered in view of what is already well known in the art at the time of filing (See *Hybritech, supra* at 94 (stating that "a patent need not teach, and preferably omits, what is well known in the art.") (emphasis added)). Furthermore, an invention can be enabled, even if some experimentation is necessary, although the amount of experimentation needed must not be unduly extensive. (See *Hybritech, supra* at 94, citing *Atlas Powder Co. v. E.I. duPont De Nemours & Co.* 224

USPQ 409, 413 (Fed. Cir. 1984)). The determination of what constitutes “undue experimentation” depends on the nature of the invention and the state of the art. (*See In re Wands*, 8 USPQ2d 1400 (Fed. Cir. 1988)). The test is not merely quantitative, since a considerable amount of experimentation is permissible if it is routine or if the specification provides a reasonable amount of guidance. *Id.* Among factors that courts have considered as to whether or not the extent of experimentation is undue include: (1) the quantity of experimentation; (2) the amount or direction of guidance; (3) the presence or absence of working examples; (4) the nature of the invention; (5) the state of the prior art; (6) the relative skill of those in the art; (7) the predictability or unpredictability of the art; and (8) the breadth of the claims. *Id.*

The Office has misapplied or ignored many of the factors set forth in *In re Wands*, *supra*, for analysis of whether a person of ordinary skill in the art would have been able to practice Applicants invention without undue experimentation. For example, the Office action has considered the *breadth of the claims*, and the *unpredictability of the art*, but continues to discount other significant factors, including especially the *nature of the invention*, the *state of the prior art*, the *relative skill of those in the art*, and the *amount of guidance* provided in the specification, particularly as it relates to the as-claimed inventions.

In this regard, a person of ordinary skill in the art would have appreciated that the invention defined by the instant claims relates to a protocol involving a format for preparing and screening arrays of non-biological organic polymers – that is completely general to, and independent of, the particular types of polymerization chemistries (*e.g.*, polymer structures) and polymerization reactions. (See paragraph 22 of the Declaration of Adam L. Safir). Accordingly, the concerns expressed in the Office action relating to the scope of the polymer structure and to the inherent uncertainty of polymerization chemistries and reactions is misplaced in this instance. Contrary to the apparent view of the Office, the present invention is not directed toward *new* polymers or *new* polymerization syntheses mechanisms *per se*; rather, the nature of the invention resides in protocols that employ a new format for preparing an array of polymers on a substrate.

The state of the art for polymerization chemistry is well developed. (See paragraphs 5 and 21 of the Declaration of Adam L. Safir). Moreover, relative skill of

those in the art is high. One of ordinary skill in the art can be expected to have a Ph.D. in Chemistry and/or to have worked as a scientist in a polymer chemistry laboratory. (See paragraph 21 of the Declaration of Adam L. Safir; see also paragraph 4 at page 7 of the previous Office action dated December 11, 2003).

Moreover, the specification provides substantial guidance with respect to the defining features of the invention *as claimed* – the preparation of diverse polymeric materials in a spatially addressable substrate format. (See paragraph 23 of the Declaration of Adam L. Safir). In particular for example, an overview of general and specific approaches is provided (*See* page 12, line 1 through page 17, line 4 of the specification), together with specific details regarding various component-delivery approaches. Among others, gas-phase chemical processes and liquid-phase chemical processes and deposition techniques are disclosed in significant detail. These techniques are particularly suited to delivery of monomers, including delivery techniques for solution-phase monomers (*e.g.* with a dispenser), and are expressly taught as being suitable for delivery of non-biological polymeric components. (*See, for example, page 29, line 24 through page 36, line 12 of the specification.*) The specification also describes various approaches for isolation of predefined regions (*See, for example, page 17, line 6 through page 22, line 6 of the specification*). Reaction of monomers and optionally other delivered components is also particularly described with respect to non-biological polymeric materials. (*See, for example, page 38, line 27-33 of the specification*). Various reaction protocols that are particularly effective in connection with bulk polymerization reactions, such as stirring and/or pressurizing and/or heating during the reaction, are likewise disclosed. (*See, for example: page 36, lines 17-21 and page 37, lines 25-28 (heating); page 36, lines 25-30 (mixing); and page 37, lines 23-25 (pressurizing)*). Intermittent reaction processing steps are likewise disclosed. (*See, for example, page 37, line 29 through page 38, line 3*). The specification further teaches that the arrays of non-biological polymeric materials can be screened according to many specifically-known techniques for specifically-known properties of interest. (*See, for example, page 39, line 6 through page 43, line 31 of the specification*). Moreover, as acknowledged in the Office action, the preparation of an array of non-biological polymers is exemplified in Example B – and expressly demonstrates the invention defined by the presently-pending claims.

Hence, the presently-pending claims are fully enabled, considering the *nature of the invention*, and considering that a *highly skilled polymerization chemist* can practice the invention based on the *guidance in the specification* (particularly, the guidance that is relevant to the nature of the invention) and based further on the *substantial warehouse of knowledge already existing in the art* of polymerization chemistry.

Significantly, facts of record in the instant application definitively demonstrate that the present invention can be and has in fact been practiced by a person of ordinary skill without undue experimentation. (See paragraph 21 of the Declaration of Adam L. Safir). Specifically for example, a number of references demonstrate that Applicants' invention has already been applied in the polymer arts without undue experimentation. These references are attached to and discussed in the Declaration of Adam L. Safir, and include:

Exhibit B - United States Patent No. 6,584,832 (2003);
Exhibit C - "Separation Approaches Toward Rapid and Complex Molecular Characterization of Diverse Polymers," (2003);
Exhibit D - PCT Patent Application WO 02/14377 (2002);
Exhibit E - United States Patent Application 10/333,065, Publication No. US 2003/0157566 A1 (2003); and
Exhibit F - "Water-Compatible Molecularly Imprinted Polymers Obtained via High Throughput Synthesis and Experimental Design" (2003).

(See paragraph 5 of the Declaration of Adam L. Safir). Notably, each of these references disclose polymerizations that were effected using protocols and formats similar to that disclosed in the specification, without reporting the need to overcome any problems that would require further experimentation. (See paragraphs 6-21 of the Declaration of Adam L. Safir).

Moreover, the Office's analysis of other factors delineated in *In re Wands* do not detract from the conclusion that each of the presently-pending claims are fully enabled.

In particular for example, although the Office acknowledges that the invention is enabled as to polymerization using monomers described in Example B of the specification, the Office nonetheless attempts to limit Applicants' invention to the specific examples. The Office asserts that there is a need for a broader range of examples that demonstrate the use of Applicants invention across a broader range of polymerization reactions. However, the Office's position in this regard is misplaced – both legally and factually. The law explicitly holds that "(n)othing more than objective enablement is required, and therefore it is irrelevant whether this teaching is provided through broad terminology or illustrative

examples. *In re Marzocchi*, 169 USPQ 367, 369 (CCPA 1971). Further, considered factually, the Office's position is misplaced in view of the *nature of the invention*, the *state of the art* (acknowledged as being highly developed for polymerization), the *level of skill in the art* (acknowledged as being relatively high) and the *level of guidance* provided in the specification, as discussed in detail above. Example B of the specification demonstrates application of the invention using initiated polymerization schema; a person of ordinary skill in the art would have readily appreciated that such schema could be extended to copolymerizations and higher-order polymerizations using other monomer sets (besides the specifically disclosed monomers used in the reaction). The Office's position is also demonstrably misplaced in view of other facts of record, discussed above, that demonstrate that the present invention has in fact already been practiced by a person of ordinary skill without undue experimentation.

The Office action does not assert or demonstrate in any respect that the *quantity of experimentation* required to practice the invention would be extensive. Moreover, the law is clear that a considerable amount of experimentation is permissible if it is routine or if the specification provides a reasonable amount of guidance. (*See In re Wands, supra*). Also, there is no requirement that an invention be completely operable and successful in operation 100% of the time. (*See In re Wands, supra*). In the present case, the guidance of the specification, applied by a highly-skilled polymerization chemist relying on chemistry knowledge existing in the art could have practiced the invention using only routine experimentation.

As to independent claim 163 (and claims depending therefrom), the position of the Office appears to be unfounded and contrived. This claim is directed to evaluating an array of polymers of a particular polymer type – polycarbonate polymer materials. As such, the underlying factual premise of the Office's position – that the scope of the claims are broad with respect to polymers – does not apply to claim 163. Therefore, the general rationale set forth in the Office action with regard to enablement is largely, if not completely inapposite to the more narrowly-drawn invention defined by claim 163. Since the scope of claim 163 is commensurate with the scope of disclosure in the specification, under *In re Marzocchi, supra*, the Office action does not set forth a *prima facie* case of non-enablement with regard to this claim. The Office action states only that

(a)s for claim 163... requisite guidance and direction is lacking. There is a gap between what the specification teaches, and making and using ten or more polymers in the claimed invention.

See paragraph 24 at page 9 of the Office action. The Office does not provide any further explanation as to why a person highly skilled in art of polycarbonate polymer chemistry could not practice the invention of claim 163 in view of the guidance set out in the specification and in view of the extensive prior art relating to polycarbonate polymerization chemistry. As such, the Office presents only a bald, unsupported assertion, and completely ignores the specification, Applicants comments relating thereto, and the evidence of record. See, for example, paragraph 23 of the Declaration of Adam L. Safir, and related discussion as set forth above.

In conclusion, the Office action has not established a *prima facie* case of non-enablement. The Office has selectively focused on certain aspects of the claims (*e.g.*, polymer structure), while disregarding other significant and characterizing aspects of the claims (*e.g.*, polymerization in an array format) – thereby inaccurately characterizing the nature of the invention. Although the claim is broad with respect to type of polymers, the claim has other distinctive features that distinguish the art as a whole – as already acknowledged in the Office action (having withdrawn all prior-art based rejections). It is these other distinguishing features that define the nature of the invention, and that have been disregarded by the Office in evaluating enablement. Further, the Office has placed an undue emphasis on the extent of unpredictability with respect to discovering *new* polymer structures or *new* polymerization reaction mechanisms. As noted above, Applicants are not claiming new polymer structures or new reaction mechanisms *per se*. Moreover, the law only requires that Applicants enable polymer structures and polymerization reactions that were known in the art at the time the application was filed; Applicants do not have to enable new inventions that were yet undiscovered at the time of filing of the application. Moreover, the Office inappropriately discounts the substantial *guidance* provided in the specification, the level of skill in the art, and the extensive knowledge about polymerization chemistry that already exists in the art. In view of the above remarks, complete and accurate consideration of the *In re Wand* factors clearly

demonstrate that a skilled person could practice the instant inventions without undue experimentation.

The facts underlying the position set forth by Applicants herein have been established as *evidence* made of record. The Office cannot ignore such evidence, and unless it can present its own evidence that disproves or otherwise counters the evidence of record, the Office must take these facts in evidence as being true. When the law is accurately applied to the facts in evidence, the inventions defined by the presently pending claims are clearly enabled.

Accordingly, Applicants respectfully request that this rejection be withdrawn.

Information Disclosure Statement

An Information Disclosure Statement is being filed on the date even herewith listing newly cited references. Consideration of the pending claims is respectfully requested, in particular, in view of the newly cited references.

CONCLUSION

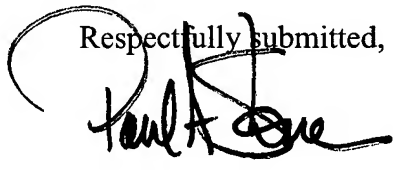
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Applicants believe that no further fees are required in connection with this Amendment F. If necessary however, the Examiner is also authorized to debit any necessary fees for this amendment, or any other fees required in connection with this application, or to credit any overpayment of fees in connection with this application to Deposit Account No. 50-0496.

Date Submitted: Nov. 3, 2004

Symyx Technologies, Inc.
3100 Central Expressway
Santa Clara, CA 95051
Phone: (408) 773-4027
Fax: (408) 773-4029

Respectfully submitted,


Paul A. Stone
Reg. No. 38,628